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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/211,155      | 12/14/1998  | MICHAEL EPSTEIN      | PHA-23-548          | 7465             |

7590

04/09/2003

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EXAMINER

CALLAHAN, PAUL E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2134

DATE MAILED: 04/09/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/211,155

Applicant(s)

EPSTEIN

Examiner

Paul E. Callahan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4-11, 13-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, 13-18, and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1, 4-11, 13-18, and 20 are pending in this application and have been examined.
2. The Notice of Appeal received 6-21-02 has been deemed erroneous as per the subsequent communications from the Applicant's Representative. Accordingly the Notice of Appeal has not been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 1-24-203 have been fully considered but they are not persuasive. Applicant argues again that the Tomko '912 and the Chaum '870 references do not teach the feature found in the Applicant's independent claims of: "The apparatus comprising an authentication encryptor that encrypts a challenge parameter using the decrypted PIN provided by the processor" However the Examiner counters again, as was noted in the previous Office Action in the case, such is taught in the Chaum reference at col. 12 line 63 through col. 13 line 8, and encrypted response parameter based upon a decrypted security key is taught additionally by Chaum at col. 15 lines 5-50.

Applicant argues that the Chaum reference does not teach an encryptor or a decryptor that encrypts or decrypts challenge data. However such is indeed taught via reference to the process of encryption and decryption of the challenge data noted above.

Applicant argues that neither Chum or Tomko individually teach encryption or decryption of challenge data with a decrypted security key. The Examiner notes that it was the combination of the two references that were found to teach all limitations found in the claims not each reference separately. Tomko teaches encryption and decryption of a security key in those passages noted in the rejections of the claims. Similarly Chum teaches receipt and encryption and / or decryption of a challenge value. It was found to be an obvious step to combine these teaches to arrive at the claimed invention.

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***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-11, 13-17, 18 and 20 were previously rejected under 35 USC 103(a) as being obvious over Tomko US Patent 5,712,912, and Chaum US Patent 4,529,870. Only the language of claims 1, 9, 18, and 20 has been changed by the most recent amendment. The text of the rejections of these claims as found in the previous Office Action will not herein be repeated, but instead are hereby incorporated in their entirety by reference to the previous Office Action. Accordingly, the Applicant is referred to the previous Office Action in the case for the text of those rejections.

As per claims 1, 18, and 20, the amendment has added the language of a biometric decryptor that decrypts the encryption of the security key with the first or second biometric key. Tomko teaches generation and encryption/ decryption of a first biometric key in col. 1 line 64 through col. 3 line 37, as noted in the previous Office Action in the case. The language of a received challenge parameter being encrypted and / or decrypted with a first decrypted security key has been added. As was noted in the previous office Action in the case Tomko does not teach the use of a challenge-response protocol. However Chum teaches such where there is encryption of a received challenge parameter with a security key in col. 12 lines 63 through col. 13 line 18. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated these steps of Chaum into the system of Tomko, specifically including the use of the decrypted security key of Tomko as the key for encrypting the received security parameter of Chum. It would have been desirable to so as this would allow for increased security in the communications system of Tomko through the use of such an authentication routine as found in Chum.

As per claims 9 and 18, the amendment has added the additional limitation of producing a decrypted security key by use of the first biometric key. Tomko teaches this at col. 1 line

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64 through col. 3 line 37. The added language of the access device determining an access status based upon the response parameter. Tomko does not teach this feature, however such is taught by Chaum in col. 2 line 65 through col. 3 line 37, and fig. 5 item 504. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated these steps of Chaum into the system of Tomko. It would have been desirable to so as this would allow for increased security in the communications system of Tomko through the use of such an authentication routine as found in Chum.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 6.

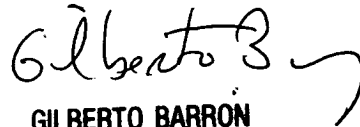
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239 Official Faxes, X-7240 Unofficial Faxes, X-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

4//4/03

Paul Callahan

  
GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
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